

**REMARKS**

Claims 1 and 3-33 are pending in the patent application. Claims 1 and 9 are amended herein to correct a spelling error.

Claims 1 and 3-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Barrie** (U.S. Pat. No. 5,980,384). This rejection is respectfully traversed.

**Barrie** is alleged to disclose "a slot machine that has rotatable reels (Fig. 1, 1 19a- 1 19c) "bearing a plurality of discrete symbols (FIG 1, references 120a- 1 20i) and a continuous graphical element (FIG 1, references 126a-126l) extending between adjacent symbols on the reel (FIG 1) such that the discrete symbols become unified by the graphical element" (citing col. 2, lines 1-5, Fig. 1). The Examiner asserts that the reels "are operable to rotate wherein the continuous graphical element does not rotate giving it a velocity different from the discrete symbols in visual association of the display" (page 2 of Office Action). The Examiner continues to state that "[t]he reel is then stopped to place the discrete symbols in visual association of the display (FIG 1)".

The Examiner acknowledges that **Barrie** does not disclose that the continuous graphical element extends between adjacent symbols on the same row. The Examiner posits, however, that "it would have been obvious to one of ordinary skill in the art to allow the continuous element to run vertically, thus existing separately on each row and asserts that "[t]he functionality would still remain the same, as there is the same number of elements vertically as there are horizontally and the change would have no affect on the game as disclosed", further alleging that the change would be a matter of "design choice". The Examiner further alleges that [m]otivation for using a vertical element over the disclosed horizontal one would be to not have the elements crossing the

reels, thus eliminating possible confusing for how the elements play in the game, or when incorporating vertical paylines as disclosed by Barrie (Column 4, lines 12-28)".

Independent claim I recites a slot machine comprising "*a rotatable reel, the reel bearing a plurality of discrete symbols and a continuous graphical element* extending between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element."

Claim I also recites "a processor operable to *rotate the reel* to give the continuous graphical element a first velocity and at least one of the plurality of discrete symbols a different second velocity" (emphasis added). Claim 9 similarly recites "a slot machine comprising *a rotatable reel, the reel bearing a plurality of discrete symbol positions and a continuous graphical element* extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element, the reel also bearing a discrete symbol, and a processor to *rotate the reel* to give the continuous graphical element a first velocity and the discrete symbol a different second velocity to allow the discrete symbol to move between the adjacent ones of the discrete symbol positions as the reel is rotated." (emphasis added).

As to claims I and 9, it is the reel that bears both the plurality of discrete symbols (cl. 1) or discrete symbol (cl. 9) and the continuous graphical element (cl. 1, 9). The Examiner's statement of reasons for rejection are premised upon an interpretation of **Barrie** wherein **Barrie** discloses "a slot machine that has rotatable reels ... bearing a plurality of discrete symbols (FIG 1, references 120a- 1 20i) and a continuous graphical element (FIG 1, references 126a-1261) extending between adjacent symbols on the reel (FIG 1) such that the discrete symbols become unified by the graphical element" (citing col. 2, lines 1-5, Fig. 1). However, reels 119a-119c do

not bear a continuous graphical element. The alleged continuous graphical elements 126a-1261 are not borne by the reels I 19a- 1 19c, but are separate therefrom.

Similarly, claim 18 recites a method of conducting a slot game on a slot machine controlled by a processor, comprising receiving a wager from a player and *rotating a reel, the reel bearing a plurality of discrete symbols and a continuous graphical element . . . the rotating wheel moving the continuous graphical element at a first velocity* (emphasis added).

Independent claim 25 likewise provides a method of conducting a slot game on a slot machine controlled by a processor, comprising receiving a wager from a player, *rotating a reel with a first velocity, the reel bearing a plurality of discrete symbol positions and a continuous graphical element* extending between adjacent ones of the discrete symbol positions. . . . " (emphasis added). As noted above, reels 119a-119c of **Barrie** do not bear a continuous graphical element. The alleged continuous graphical elements 126a- 1261 are not borne by the reels 11 9a- 1 19c, but are separate therefrom.

#### I. ALL CLAIM ELEMENTS NOT CONSIDERED BY EXAMINER

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); " *see also In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)(stating "[w]hen evaluating the scope of a claim, every limitation in the claim must be considered"); *In re Lowry*, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994); MPEP §§706.020); 2142; 2143; 2143.03.

In accord with the claims and the specification (see, e.g., exemplary FIGS. 3-6 and associated descriptive text), the "continuous graphical element" (e.g., 62, FIG. 5) is borne by the reel (e.g., 30, FIG. 5). The Examiner's statement that **Barrie** discloses "a slot machine that has

Application No. 09/992,392 Amendment & Response to Office Action dated June 25, 2004  
rotatable reels ... bearing a plurality of discrete symbols ... and a continuous graphical element" demonstrates that the Examiner did not duly consider the fact that the claims require the continuous graphical element to be borne by the reels (e.g., reels 119a-119c in **Barrie**). The Examiner's own statement that "[f]he reels are operable to rotate wherein the continuous graphical element does not rotate" stands as manifest evidence that the Examiner failed to consider the claims, as presented, and it is accordingly submitted that the Examiner's treatment of the claims fails to present a *prima facie* case of obviousness under 35 U.S.C. § 103. Reconsideration and withdrawal of this rejection is requested for at least this reason.

To the extent that the Examiner would assert that all words in the pending claims were properly considered, it is submitted that such interpretation of the claim language would be impermissibly broad. Claims must be read as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 218 USPQ (Fed. Cir. 1983). The "broadest reasonable interpretation" of the claims permitted by law must be consistent with "the interpretation that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In this vein, "[c]laims are not to be read in a vacuum, and limitations therein *are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'*." *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983)(italics added). It is submitted that one of ordinary skill in the art would not have reasonably interpreted the above noted claim language, in light of the specification, as including a reel bearing discrete symbols and display elements separate from the reels bearing a continuous graphical element, as argued

by the Examiner. It is therefore submitted that such interpretation by the Examiner would be unreasonably broad and improper.

## II. ALL CLAIM ELEMENTS NOT TAUGHT OR SUGGESTED BY BARRIE

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

As noted above, **Barrie** does not teach "a slot machine that has rotatable reels ... bearing a plurality of discrete symbols ... and a continuous graphical element" as variously claimed in the independent claims. It is submitted that **Barrie** does not suggest such claimed features, as secondary game positions 126a- 1261 are distinct elements separate from reels 119a-119c.

**Barrie** teaches that "the secondary game has game symbol display positions designated 126a- 1261 that are located on either side of each of primary game display positions 120a- I 20i, as shown." (col. 4, lines 44-48). "In the secondary game positions 126a-1261 are displayed the same traditional game symbols such as a bell 122, plum 123, orange 124, seven and Joker (both not shown), and cherries 125." (col. 4, lines 48-52). "After each play of the primary game the game symbol appearing in each of the secondary game positions 126a, e, i, d, h, I along the far left and far right vertical edges of playing field 113 will automatically change to match the game symbols that appear in the adjacent one of primary game display positions 120a,b,c,g,h,i unless the symbol in one of these primary game display positions is the Flip-Flop symbol 132." (col. 4, lines 53-60. This is done in accordance with one of the features of the invention wherein primary game symbols move to secondary game display positions. "The particular game symbol in each of secondary game positions 126b, cfgJk do not change except by transposition of game symbols between these secondary game positions as described below with reference to the function of the

Flip-Flop symbol." (col. 5, lines 16-21). "The purpose of the Flip-Flop primary game symbol 132 is to indicate that horizontally adjacent secondary game symbols may be transposed horizontally to improve the chance of the player winning in the secondary game." (col. 5, lines 22-25).

The question of whether a claim limitation may be within the level of ordinary skill in the art, whether such assertion is explicit or implied, is not a sufficient basis for concluding that the claimed subject matter would have been obvious under 35 U.S.C. § 103. That which is or may be within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980); *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1092 ffi. 16 (Fed. Cir. 1985). Indeed, it is well settled that there must be some motivation that would have led one of ordinary skill in the art to modify the prior art reference (in this case, **Barrie**) to arrive at the claimed invention. See, e.g., *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *Al-site Corp. v. VSHnt 7 Inc.*, 174 F.3d 1308 (Fed. Cir. 1999); *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000).

A key feature of the invention is that the claimed invention has a reel bearing one or more discrete symbols and a continuous graphical element, wherein the reel's discrete symbol(s) and the reel's continuous graphical element are configured to move at different velocities. This is exemplified in the examples provided in the specification. The specification states, as one example, that "during the drag race each dragster 64 moves along the continuous graphical element 62 (e.g., road), between adjacent ones of the discrete symbol positions, as the associated reel is rotated" (page 6, lines 25-27). "The speed of each dragster 64 is based on the speed of rotation of the associated reel" (page 6, lines 27-28). In accord with this example, "[b]oth dragsters 64 preferably move at similar, but slightly different, speeds such that they both remain

visible on their respective reels but at horizontal positions slightly offset from each other." (page 6, lines 29-32). The Examiner's conclusory assertion that the stationary secondary game positions 126a-1, are equivalent to or otherwise constitute the claimed continuous graphical element are inapposite, unfounded, and do not adequately address the issue of motivation to modify. First, the secondary game positions 126a-1 are in no way equivalent to the disclosed and claimed continuous graphical element. In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents (which is not the case). *In re Ruff*, 256 F.2d 590 (CCPA 1958). This burden on the Examiner has not been discharged. Second, as to the claim's requirement that the reel's continuous graphical element 66 extends between adjacent ones of the discrete symbols such that the discrete symbols are unified by the graphical element" (cls. 1, 18) or that it "extends between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element" (cls. 9, 25), the Examiner's prima facie case of obviousness is predicated upon an alleged 66 unification" of discrete symbols by the continuous graphical element gleaned from by Barrie's disclosure that:

An encouraging game environment will be provided in games that have a primary game and a physically integrated *secondary game, and a player is provided the chance to win separately at the two games. The two integrated games make it appear to the player that there is an increased chance to win. Action in the secondary game is typically triggered in two ways: (1) by some event in a single play of the primary game and, (2) game strategy dependent on and spanning a number of primary game plays.*

(col. 1, line 66 to col. 2, line 7)(italicized text cited by Examiner). This disclosure describes the general linkage of a secondary game to a primary game. This disclosure is factually insufficient to support, explicitly or inherently, a teaching or suggestion of providing a continuous graphical

element on a reel and unifying discrete symbols on the reel through such continuous graphical element. Reels I 19a- 1 19c of FIG. I also do not teach or suggest a continuous graphical element unifying discrete symbols on the reel, as claimed.

As a *prima facie* obviousness of a claimed invention requires that all of the claim limitations must be taught or suggested by the prior art (see *In re Royka, supra*) and that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art" (see *In re Wilson, supra*), it is submitted that the Examiner has not set forth a *prima facie* case of obviousness for want of the requisite factual basis. The factual showing must be clear and particular. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *CR. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). The Examiner's burden to set forth a *prima facie* case of obviousness has not been discharged, as broad conclusory statements, standing alone, are not "evidence" supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

## CONCLUSION

As C.F.R. § 1.104(c) requires the Examiner to "cite the best references at his or her command" and, in view of MPEP § 707.07(g)), which requires rejections to include all valid grounds available, it is the Applicant's belief that all of the claims are patentable and are in condition for allowance, and action towards that end is respectfully requested.

No fees are due in connection with this Amendment. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00119USPT.

Respectfully submitted,

September 23, 2004

Date

  
William D. Pegg  
Reg. No. 42,988  
JENKENS & GILCHRIST, P.C.  
225 West Washington Street, Suite 2600  
Chicago, IL 60606-3418  
(312) 425-3900 – Telephone  
(312) 425-3909 – Facsimile

Attorneys for Applicants